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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,826	02/22/2002	Frank Himmelsbach	5/1315US	7064

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EXAMINER

BERCH, MARK L

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,826

Applicant(s)

HIMMELSBACH ET AL.

Examiner

Mark L. Berch

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 13-16 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-6, 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Chackalamannil.

See species 87-88. This corresponds to R4 = amino substituted by R20, where R20 is the 8th one listed on page 231. For claim 15, note diabetes listed in claim 31 of the reference. The synthesis is the same.

The circumstances with regard to priority are as follows:

The claim for priority submitted 3/22/02 lists two applications: 10117803 and 10203486

The priority papers themselves are three: 10117803 and 10203486 and 10901021 ✓ ✓ 10109021

The translations are three: 10117803 ("5/1317") and 10901021 ("5/1315") and "1/1247".

Thus, there is 10203486 with no translation, and there is "1/1247" with no priority document. These two are definitely not the same. The examiner notes that the oath's

priority claim also lists 10140345. It is possible that this is what "1/1247" translates, but the examiner cannot tell. Applicant cannot rely upon 10203486 or 10140345 to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

However, not one of these three translations has the scope of these claims. For example, R1 can be a substituted alkenyl which is not seen. The amino-piperidone choices for R4 at the last line of page 231 are also not seen, and there are other examples as well. To gain benefit, applicants must supply a document and its translation which fully supports the claims (or, alternatively, identify the provisional application which has this, as none appear to.)

Claims 1-6, 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanstrup.

See examples 6-7, 9-12, 14-15, 17-21, 24-25, 28-29, 34-45, 47-60, 62-70, 75-78, 81-85, 89-95, 97-98, 100, 102-104, 107-110, 113, 134-137, 143-144, 147-151, 162, and 165-166. These correspond to the R3 choices as set forth on page 229, lines 4-5 and all avoid the first proviso of page 233. With regard to claim 13, note that these compounds are generally TFA salts. Diabetes and obesity are mentioned, and the synthesis is the same.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chackalamannil.

See above rejection. Although the compounds are not in the salt form, the reference teaches salts generally, see paragraph 0081. Hence, their use would be obvious.

Claims 1 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 37-4895.

See the attached index sheet which shows the relevant species. This corresponds to the R4 = NR15R16 choice, where R16 is diethylamino propyl. The sole difference is that the claim requires R15 as methyl, while the reference has H. Such a variation is considered obvious because of the close structural similarity. See *In re Hoeksema*, 154 USPQ 169; *Ex parte Weston*, 121 USPQ 428; *Ex parte Bluestone*, 135 USPQ 199; *In re Doebel*, 174 USPQ 158. Note also *In re Jones*, 21 USPQ2d 1942, which states at 1943 "Particular types or categories of structural similarity without more, have, in past cases, given rise to *prima facie* obviousness"; one of those listed is "adjacent homologues and structural isomers".

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 and 12-16 are rejected under 35 U.S.C. 112, paragraphs 1 and 2, as the claimed invention is not described, or is not described in such full, clear, and exact terms as to enable any person skilled in the art to make and use the same, and/or failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. Specifically:

The aspect which is problematic is the provision of methylated or ethylated at the 9 position, provided for in the middle of page 233. That would quaternize the N, and thus give it a molecule with a plus charge but no minus charge. A molecule without electrical neutrality is impossible to prepare and hence lacks enablement in terms of how to make, as such a thing cannot be made (paragraph 1). Note MPEP 2172.01: "A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. In re Mayhew, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See also MPEP § 2164.08(c). Such essential matter may include missing elements ...". Here, the missing counterion is the missing element. On the other hand, if it was not the intention of applicants to claim such a non-neutral molecule, then the claim fails to set forth what applicants intend as their invention (paragraph 2). That is, it is not accurate because it is missing something, viz. the anion. As stated in *In re Zletz*, 13 USPQ2d 1320, 1322, "An essential purpose of patent examination is to fashion claims that are precise, clear, correct and unambiguous." The specification provides no guidance in this matter.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.


Allograft transplantation is not a "disease". Was something else intended?

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 708-308-1235.


Mark L. Berch
Primary Examiner
Art Unit 1624

December 20, 2002